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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,510	11/02/2001	John J. McKillip	72412	6502

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FITCH EVEN TABIN AND FLANNERY
120 SOUTH LA SALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

EXAMINER

EICKHOLT, EUGENE H

ART UNIT PAPER NUMBER

2854

16

DATE MAILED: 06/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,510

Applicant(s)

MCKILLIP, JOHN J.

Examiner

Eugene H Eickholt

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 9, 12 and 15 is/are rejected.
- 7) ☒ Claim(s) 10, 11, 13, 14 and 16 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 16.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth (6,071,585) in view of Chess (5,324,153).

Roth teaches all the steps of these claims except his printing step occurs downstream of the adhesive patch application step. Roth suggests to one of ordinary skill in the art the use of "stock" page 2 at column 3, line 59, by referring to use of "commercially available paper". Application of adhesive is taught at column 6, lines 18-20. The adhesive and silicone form the patch material being applied as set forth in the passage at column 5, lines 25-30. The formed patch is die cut with the cuts contiguous with the patch materials as set forth in column 7, lines 4-15.

Chess teaches the print station 37 shown in Fig. 1 after patch application may also be in front of application wheel 27. See column 4, lines 10-13. Motivation for placing the printing station as taught by Chess ahead of the patch application station would be where the patch is to cover the printing as contrasted with being placed on the other side of the stock paper. Note that Roth teaches printing may occur on either side of the paper web at column 2, lines 25-27.

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Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roth in view of Steidinger et al.

Roth is directed to printed business form. See column 1, lines 13-14. Claim 15 refers to a source of stock paper. Roth at column 3, line 59 refers to "commercially available paper" which inherently includes "stock" paper. Roth teaches use of paper in any of continuous paper roll, zig-zag or individual sheet form which inherently would require unwinding from a roll form of continuous sheet to enable passage through the printing press and adhesive application stations for the patch. Printing is taught for the patch. Printing is taught by Roth after adhesive patch application at column 6, line 33. Figure 2 shows "indica has been printed by the press. Application of adhesive is taught on the backside of the printable web at column 6, lines 18-20. The adhesive and silicone form the patch material being applied as taught in column 5, lines 25-30. The formed patch is die cut with the cuts contiguous with the patch materials set forth at column 7, lines 4-15. The receiving at a finishing station step is not taught by Roth. Steidinger et al teaches one of ordinary skill in the printing art at the time of applicants invention receiving any of a roll 165, single sheets 164 or a roll of fan-folded continuous web.

It would have been obvious to receive the Roth roll, cut sheet or fan-fold label as taught by Steidinger et al at column 7, lines 26-31. Motivation would have been the orderly collection of completed integrated label and carrier products.

Claims 10-11, 13-14 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. A shortened statutory period of 3 months is set to respond.

Eickholt/ek

06/03/03


EUGENE H. EICKHOLT
PRIMARY EXAMINER